

Application Serial No. 10/801,956

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AUG 14 2006

Remarks/Arguments:

Claims 1-80 are pending. Claims 4, 9, 20, 29, 38, 48, 62, and 71-73 are withdrawn from consideration in response to the restriction requirements. New claims 74-80 are added to reflect the election of a specific combination of DNA markers from claims 4, 9, 20, 29, 38, 48, and 62, respectively. Claim 17 is amended to correct a typographical error. Claims 6, 17, 26, 35, 44, and 58 are amended to promote the clarity of the claims. Support for these amendments can be found, e.g., at page 19, lines 21-24. No new matter is introduced.

Election within Group I

In the Restriction Requirement, the Examiner required an election between two groups of claimed inventions:

- I. Claims 4-5, 9-10, 20-21, 29-30, 38-39, 48-49, and 62-63, drawn to a method of detecting DNA markers in 12q22-23, classified in class 435, subclass 6.
- II. Claims 71-73, drawn to products to detect markers of 12q22-23, classified in class 536, subclass 24.3.

The Examiner further required that, upon election of Group I, Applicants must elect a specific marker or specific combination of markers from claims 4, 9, 20, 29, 38, 48, and 62 to which the claims will be limited. This restriction requirement is respectfully traversed.

Claims 4, 9, 20, 29, 38, 48, and 62 are drawn to methods where one or more of DNA markers D12S1657, D12S393, D12S1706, and D12S346 can be included in a panel for detection. Applicants provisionally elect a combination of D12S1657, D12S393, D12S1706, and D12S346 for prosecution on the merits. Since all four markers will be searched in view of Applicants' election, no additional search would be needed for examining claims involving one-, two-, and three-marker panels.

Moreover, there is no indication in the Restriction Requirement that each individual marker and different combinations of the four markers would be classified separately. In addition, the four markers are closely related. All of them

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are microsatellite markers located at 12q22-23. As such, the status in the art and the field of search for each of the markers and different combinations of the markers would largely overlap. There would be no serious burden on the Examiner if no restriction is required among the individual markers and different combinations of the markers.

In view of the foregoing, the Examiner is respectfully requested to withdraw the restriction requirement within Group I.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,  
HOGAN & HARTSON L.L.P.

Date: August 14, 2006

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